

Appl. No. 09/647,833
Atty. Docket No. AA307F
Amtd. dated October 9, 2003
Reply to Office Action of 07/09/03
Customer No. 27752

REMARKS

Claims 1 and 3-12 are pending in the present application. No additional claims fee is believed to be due.

Claims 1, 11, and 12 have been amended to better describe the claimed invention, correct antecedent basis issues, element designations a-d, and grammatical errors. Claims 3 and 10 have been amended to correct grammatical errors. Support for the amendments is found in Figures 2a, 2b, 3, and 4.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Applicants would like to thank the Examiner in the examination of the above identified Application. This response fully addresses the issues raised in the Office Action dated July 9, 2003. A detailed discussion of each issue is provided in the sections that follow.

Rejection Under 35 USC 112, First Paragraph

The Office Action states that claims 1 and 3-10 are rejected under 35 U.S.C. § 112, first paragraph. The Office Action provides that the claims fail "to comply with the written description requirement."

The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claim 1 to include the limitation "wherein the reinforcement nonwoven does not extend the entire longitudinal length of the absorbent article." Applicant has relied on Figure 2a of the disclosure for support of the limitation. However, Figure 2a, as described in the disclosure depicts a lateral cross-section of the absorbent article (page 3, lines 4-5) and cannot be relied on to show the relationship of the reinforcement nonwoven to the longitudinal length of the article of the present invention.

Applicants respectfully traverse the rejection of the Office Action. The specification provides that "the reinforcement nonwoven 90 may alternatively be provided in any or all of the front, crotch, and rear regions of the diaper. It may be provided as a unitary piece of nonwoven material, which is preferred as described above, or may alternatively be provided in discrete pieces." (page 10, lines 12-15). Because the specification allows for the reinforcement

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nonwoven to be placed in any of the regions of the diaper, i.e. the front, rear, or crotch region, the reinforcement nonwoven is therefore not required to be in all regions of the diaper. So, the above mentioned claim limitation has support within the specification. Therefore, withdrawal of the 35 U.S.C. § 112 first paragraph rejection is requested.

Rejection Under 35 USC 102 Over Saisaka et. al

The Office Action provides that claims 1 and 3-10 are rejected under 35 U.S.C. § 102(a) as being anticipated by Saisaka et. al, U.S. Pat. No. 5,624,424. The Office Action rejects claim 11 on the same basis. Applicants respectfully traverses the rejections of the Office Action.

A cited reference anticipates a claimed invention if the cited reference sets forth each and every element of the claimed invention either expressly or inherently. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The current invention is aimed at making the user feel comfortable in wearing the diaper. The use of liquid impervious backsheets, while preventing liquid "from passing through the diaper," may also make the diaper feel hot and uncomfortable particularly in the rear waist and side ear regions. (pg. 1, lines 28-32). "Some disposable diapers are provided with a nonwoven material laminated or otherwise adhered to the backsheet film to provide the appearance of cloth and cloth-like feel...." (pg. 1, lines 33-35). However, these garments may be bulky because of the use of excess material. Moreover, the cost of the garment increases with the increased use of raw materials which occurs with the incorporation of the nonwoven over the backsheet film. (See pg. 2, lines 2-5). The present invention seeks to alleviate these issues.

First, with regard to claim 1, the Saisaka et. al reference teaches side liner sheet layers 22 that extend the longitudinal length of the article. (See Figures 2-3, 6, 8, 10, and 13-14). In contrast, claim 1 recites, *inter alia*, "wherein the reinforcement nonwoven does not extend the entire longitudinal length of the absorbent article." Thus, the Saisaka et. al reference does not teach all of the elements of claim 1.

Second regarding both amended claim 1 and amended claim 11, the Saisaka et. al reference fails to teach all of the claimed elements of these claims. Amended claim 1 and claim 11 recite, *inter alia*, that the reinforcement nonwoven is joined to the body facing surface of the backsheet and "to at least one of either the garment facing surface of the rear ear panels or the garment facing surface of the front ear panels so as to form a portion of the garment facing surface of the absorbent article...." In contrast, the Office Action refers to item 22 (side liner sheet layers), in the cited reference, as the reinforcement nonwoven. (See Office Action, page 4.

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item (d)). However, Figures 3 – 10 and 13 – 14, of the Saisaka et. al reference show that the outermost sheet layer 21, the outer surface of which corresponds to the garment facing surface, extends out just as far as the side liner sheet layers 22. So, if the outermost sheet layer 21 extends out just as far as the side liner sheet layers 22, then the alleged “reinforcement nonwoven” cannot form a portion of the garment facing surface as required by the claim limitations of independent claims 1 and 11.

Because of the existence of the outermost sheet layer 21, the Saisaka et. al reference does not solve the problem of a bulkier diaper, nor does it solve the problem of additional costs due to the use of more raw materials. The present invention eliminates the equivalent of the outer most layer 21 and simply utilizes a plastic film laminate. (page 9, lines 30-34).

Therefore, the Saisaka et. al reference does not recite all of the claim limitations of independent claim 1 which precludes the Saisaka et. al reference from anticipating the claimed invention as described in claims 1 and 11. Thus, Applicants assert that both claims 1 and 11 are in condition for allowance.

Claims 3 – 10 depend from claim 1. Because claim 1 is not anticipated by the cited reference, claims 3 – 10 are also not anticipated by that reference. Thus, Applicants assert that claims 3 – 10 are also in condition for allowance.

Rejection Under 35 USC 103(a) Over Saisaka et. al in view of Osborn, III et. al

Claim 12 has been rejected under 35 USC 103(a) as being unpatentable over Saisaka et. al in view of Osborn, III et. al. But, in order to establish a prima facie case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* Applicants traverse the rejection provided for in the above mentioned Office Action because there is no motivation to combine the cited references, and moreover, even if there were sufficient motivation to combine the cited references, the combined references fail to teach or suggest all of the claim limitations.

First, there is no motivation to combine the cited references. Osborn III et. al teaches flaps 28 which are a portion of either the topsheet 22, the backsheet 24 or a separate piece of material joined to the longitudinal edge of the sanitary napkin 20. (col. 7, lines 10 – 14). Osborn III, et. al further teaches that the flaps 28 are preferably laterally extensible from between

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about 0.5 cm and 5 cm. (col. 9, lines 62-64). The flaps 28 should "reach 25 percent extension under a tensile force of not more than about 900 grams... most preferably not more than 500 grams." (col. 9-10, lines 67-2). This works out to be approximately 444 grams / cm.¹ Additionally, the Osborn III, et. al reference teaches that a minimum tensile force of 25 grams is required. (col. 10, lines 2-3).

In contrast, the Saisaka et. al reference does not teach a minimum tensile force. Instead, the Saisaka et. al reference teaches that the "composite sheet for the side liner sheet layers preferably exhibit an elastic stress of 300g / 25 mm or less...." (col. 7, lines 12 – 14). This works out to approximately 120 grams / cm. Because, the preferred tensile strength of Osborn III, et. al. i.e. 444 grams / cm is much higher than that taught by the Saisaka et. al reference, i.e. 120 grams / cm, one skilled in the art would be discouraged from combining these two cited references. Therefore, there is no motivation to combine the cited references.

Second, assuming *arguendo* that there were motivation to combine the cited references, the cited references would still fail to establish a *prima facie* case of obviousness because the combined references fail to teach or suggest all of the claim limitations of the claimed invention. Amended claim 12 recites, *inter alia*, that the reinforcement nonwoven is joined "to at least one of either the garment facing surface of the rear ear panels or the garment facing surface of the front ear panels so as to form a portion of the garment facing surface of the absorbent article...." As discussed above, the Saisaka et. al reference does not teach or disclose a reinforcement nonwoven which can form a portion of the garment facing surface, and therefore, does not solve any of the problems that the present invention attempts to solve.

Despite the fact that the Osborn III, et. al reference discloses flaps 28 that extend beyond the edges 30 of the sanitary napkin (col. 6, lines 65-69), the addition of the flaps 28 of the Osborn III, et. al reference to the article of the Saisaka et. al reference would still provide an article with flaps or alleged reinforcement nonwovens which do not form a portion of the garment facing surface of the article. The outermost layer 21 of the Saisaka et. al reference would form the garment facing surface.

Moreover, the suggested combination of the Osborn III, et. al reference and the Saisaka et. al reference would yield an apparatus with a minimum tensile force on the alleged reinforcement flaps of 25 grams. (See Osborn III, et. al, col. 10, lines 2-3). In contrast, claim 12

¹ The resultant tensile force was determined using the preferred tensile force of 500 grams and the quotient of the preferred tensile force over 25% of the preferred distance traveled, namely the difference between .5 cm and 5 cm.

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recites, *inter alia*, "the reinforcement nonwoven having a tensile strength of at least 80 gf/cm in the traverse direction of the absorbent article." Thus, the suggested combination of Saisaka et. al and Osborn III, et. al would not yield the presently claimed invention. Therefore, the suggested combination of references does not teach or suggest all of the claim limitations as recited in claim 12.

Because there no motivation to support the Office Action's suggested combination of Saisaka et. al and Osborn III, et. al and the suggested combination would not teach or suggest all of the claim limitations as recited in claim 12, the Office Action has failed to establish a *prima facie* case of obviousness with regard to claim 12. Applicants therefore respectfully assert that claim 12 is in condition for allowance.

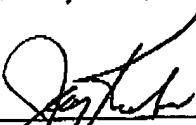
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 112 first paragraph, § 102(a), and 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1 and 3 – 12.

Respectfully submitted,
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